

been canceled without prejudice. No new matter has been added. Claims 7-10 are pending and at issue. Applicant respectfully requests reconsideration of the present application.

THE INVENTION

The invention provides kits containing a mixture of unpurified and uncharacterized recombinant enzymes which can be characterized by common chemical and physical characteristics.

I. REJECTIONS UNDER 35 U.S.C. §112

Claim 11 stands rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one of skill in the art that the inventor, at the time the application was filed, had possession of the claimed invention. While Applicant respectfully traverses these rejections, Applicant notes that these rejections are moot with respect to canceled claim 11.

II. REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claims 8-11 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant notes that this rejection is moot with respect to canceled claim 11. Applicant respectfully traverses this rejection as it may apply to the pending claims.

Specifically, the Examiner objects to the recitation of “uncharacterized enzymes” in claim 7 because claims 8-11 disclose various characterizations, such as the ability to react with the compounds of claim 8. The Examiner states that it is confusing as to how the claims can encompass kits comprising uncharacterized enzymes when the enzymes have been characterized to some extent, as shown in claim 8-11.

The relevant statute, 35 U.S.C. section 112, second paragraph (1988), requires that the claims “particularly [point] out and distinctly [claim] the subject matter which the Applicant regards as his invention.” The operative standard for determining whether this requirement has been met is “whether those skilled in the art would understand what is claimed when the claim is read in light

of the specification.” *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1576, 1 USPQ 2d 1081, 1088 (Fed. Cir. 1986). Those of average skill in the art would clearly recognize the term “uncharacterized enzymes” as reciting a term of art which describes, in part, enzymes present in the claimed kit. As noted by the Examiner, the categories of enzymes recited in the Markush group of claim 7 encompass all known enzymatic activities. Those of average skill in the art of enzymology recognize that uncharacterized enzymes are routinely categorized and sub-categorized by their interaction, or lack thereof, with specific chemical groups presented by specific substrates. Thus, claims 8, 9 and 10, which depend from claim 7, serve to further limit and group the activities of the previously uncharacterized enzymes contained in the claimed kit into further defined, yet still not completely characterized enzyme groups. Applicant submits that identifying the enzymes contained in the claimed kit as “uncharacterized” apprises those skilled in the art of the bounds of the claimed invention and is as precise as the subject matter permits.

In light of the previous discussion, Applicant respectfully requests that the rejection under 35 U.S.C. §112, second paragraph, be withdrawn.

III. REJECTIONS UNDER 35 U.S.C. §102

Claims 7-11 stand rejected under 35 U.S.C. §102 (b) as allegedly anticipated by Barns *et al.* Applicant notes that this rejection is moot with respect to canceled claim 11. Applicant respectfully traverses this rejection as it may apply to amended claim 7.

Specifically, the Examiner states that Barns *et al.* teach the collection of biomass from sediment of a hot spring in Yellowstone National Park. The Examiner further states that these samples were collected because they contained uncultivated microorganisms which excrete enzymes. The Examiner concludes that such a collection constitutes a “kit” in which individual samples in individual containers are encompassed by the present claims.

The Examiner appears to have taken the position that the present invention is anticipated by virtually any container that contains a collection of uncultivated microorganisms producing enzymes. Applicant notes that the kit of claim 7 is limited to at least one container containing a mixture of

unpurified and uncharacterized enzymes. In contrast, the method of the cited reference involves amplifying ribosomal DNA sequences obtained from archael and eucaryal organisms in order to compare the evolutionary relatedness of such organisms (pg. 1609, col. 1, last paragraph, bridging to col. 2, first paragraph, of the cited reference). While Applicant believes that claim 7 is clearly distinguishable from the cited reference in it's present form, Applicant has amended claim 7 to recite, in part, "wherein the container is free from microorganisms producing the enzymes", to further prosecution of the pending claims.

Claims 7-11 stand rejected under 35 U.S.C. §102 (b) as allegedly anticipated by Luksas *et al.* Applicant notes that this rejection is moot with respect to canceled claim 11. Applicant respectfully traverses this rejection as it may apply to amended claim 7.

Specifically, the Examiner states that Luksas *et al.* teach the existence, sale and use "Koji" culture which contains microorganisms that excrete enzymes. As noted above, Applicant has amended claim 7 to include the limitation that the container of the present invention is "free from microorganisms producing enzymes". Applicant notes that under 35 U.S.C. §102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art. In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. Applicant submits that the cited reference of Luksas fails to teach a container free of microorganisms and, therefore, cannot anticipate the claimed invention.

Applicant submits that the cited references fail to disclose the kit of the present invention because neither Barns nor Luksas teach a container containing enzymes free of the microorganism producing the enzyme. Thus, the cited references fail to teach each and every element of the claimed invention and therefore cannot anticipate the claimed invention. Accordingly, Applicant respectfully requests that these rejections under 35 U.S.C. §102(b), be withdrawn.

In summary, for the reasons set forth herein, Applicant maintains that claims 7-10 clearly and patentably define the invention, respectfully requests that the Examiner reconsider the various grounds set forth in the Office Action, and respectfully requests the allowance of the claim which is now pending.

If the Examiner would like to discuss any of the issues raised in the Office Action, Applicant's representative can be reached at (619) 678-5070.

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Respectfully submitted,

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